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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,257

06/23/2006

Graziano Vignali

NBG-115

1481

48388 7590 06/24/2009
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EXAMINER

KEMMERLE III, RUSSELL J

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,257	Applicant(s) VIGNALI ET AL.	
	Examiner RUSSELL J. KEMMERLE III	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In view of the amendment made by Applicants the previous rejection of claim 4 under 35 USC §112 is withdrawn.

Claim Rejections - 35 USC § 102/103

Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hanich (US Patent 6,228,160).

It should be noted, that claims 24-29 are product-by-process claims, and as such, determination of patentability is based on the product formed, and is not limited to products formed by the process described. See *In re Thorpe*, 777 F.2d 695, 698; 227 USPQ 964, 966 (Fed. Cir. 1985) (“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” (Citations omitted))

In the present case the product created is interpreted to generally be a ceramic article with a red-brown color covering all or part of the surface where both the silica and the surrounding ceramic material are colored by the Fe-based solutions. Referring to claims 26 and 28 this product would have a surface that is sanitized, smoothed,

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polished or lapped. Referring to claims 27 and 29 this product would be made of porcelain stoneware.

Hanich discloses a ceramic article with an iron containing stain applied to some or all of the face which fires to a red-brown color (Col 2 line 65 – Col 3 line 10). Hanich discloses that the Fe-based colorant is uniformly distributed throughout the mixture, which when fired would result in the entire body being colored (Col 2 line 65 – Col 3 line 10). This appears to meet all the limitations of the product created by claims 24 and 25. In the alternative, any slight variances in the properties of the product product made between that of the current invention and that of Hanich would have been obvious to one skilled in the art at the time of invention by Applicant.

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

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Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanich.

Hanich is relied on as discussed above but does not specifically disclose that product have a face that is smoothed or polished after firing. However these steps are commonly known to those of ordinary skill in the art as a finishing step to create a more attractive finished product. It would have therefore been obvious to one of ordinary skill in the art, at the time of invention by applicant, to have polished or smoothed the product of Hanich in order to make a finished product that is more attractive as is commonly done.

Referring to claims 27 and 29, Hanich specifically discloses that the base ceramic can be stoneware (Col 5 lines 55-59).

Allowable Subject Matter

Claims 1-23 are allowed for reasons already of record.

Response to Arguments

Applicant's arguments filed 02 April 2009 have been fully considered but they are not persuasive.

Applicants argue (through attorney remarks as well as the 132 declaration of Graziano Vignali) that the colorant of Hanich would be found only in the pores of the silica particles and not dispersed throughout the ceramic material. Applicants argue that this would be in contrast to the currently claimed invention where the colored granules containing silica and an iron compound are uniformly distributed into the ceramic composition and that the ceramic composition surrounding the colored granules

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also contains the iron compound and is colored by the same (Vignali declaration paragraph 12).

This is not found to be persuasive because Hanich discloses that the body made of a ceramic material with the stain uniformly dispersed throughout it may then be fired, which would result in at least some of the Fe-based colorant migrating from the silica particles out into the surrounding ceramic material as normally happens during heating of a ceramic body. Applicant's assertion that the stain "should" be contained only within the silica material is not found to be persuasive since it is unsupported by any evidence of what actually is observed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSSELL J. KEMMERLE III whose telephone number is (571)272-6509. The examiner can normally be reached on Monday through Thursday, 7:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. K./
Examiner, Art Unit 1791

/ Carlos Lopez/

Primary Examiner, Art Unit 1791